

REMARKS

Drawings

Formal drawings have been submitted to the patent office. Should the Examiner fail to receive the formal drawings by the time an allowance is made, please contact the attorney of record and copies of the formal drawings will be provided.

In the Claims

35 USC 102

The Examiner rejects claims 1-2, 4-7, 10 and 17 under 35 USC 102 as being anticipated by *Laughlin* '333.

Teaching of Claimed Invention Must be Found in the Four Corners of the Reference

By implication, it is being asserted that *Laughlin* teaches, within its four corners, each and every element of, in the detail and the manner of, the claims of the invention. On the law of anticipation, Judge Learned Hand stated:

No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the patent invalidated. *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942).

Accordingly, the Examiner may rely on only a single reference, and the single reference must show each and every element as set forth ("arranged") in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

Claims 1 and 17 have been amended to more clearly define the invention from *Laughlin* '333 by adding the limitation that the invention produces a fog via a plurality of spray nozzles that are coupled to *stationary* tubes (claim 1) and *stationary* nozzles (claim 17), as is supported by figure 3, and by the discussion on page 10, lines 3 - 30. This clearly differentiates the present invention from *Laughlin* '333 that teaches a single, traveling tube (the travel of the tube is how he completely coats a person). *Laughlin* '333 does not teach, show or suggest stationary tubes or

nozzles. In addition, since *Laughlin* '333 teaches away from a plurality of tubes, and teaches away from stationary spray-nozzles, Laughlin cannot be said to anticipate or make obvious the amended claim 1, or any claim depending therefrom. Accordingly, the examiner is respectfully requested to withdraw the rejections to claims 1, 17, and any claims depending therefrom, under 35 USC 102, and allowance of said claim and those that depend therefrom, is respectfully requested.

35 USC 103

Claim 11 and those that depend therefrom stand rejected under 35 USC 103 as being obvious in light of *McClain*. *McClain* teaches a torso-sized apparatus for applying a suntan lotion (*prevents* tanning) having a central neck enclosure to prevent the user's eyes from being exposed to suntan lotion. *McClain*, however, does not teach a method for applying a solution that is capable of *producing* a tan (tanning solution).

There Must Be a Basis in the Art for Combining or Modifying References

MPEP§ 2143.01 provides:

The mere fact that references can be combined **or modified** does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* to determine whether it has been properly made. Thus, *In re Geiger*, *supra*, stated, in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 221 USPQ 929,933 (Fed. Cir. 1984).

Of course, application of §103 presumes the existence of differences between the subject

matter claimed and the teachings of any particular prior art reference. Otherwise, a rejection under §102 would have sufficed. Thus, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. The Federal Circuit's assessment in *Geiger*, quoted above, is directed to the sufficiency of the teachings of a particular reference to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have found obvious to do at the time the invention was made.

Recently, Judge Newman in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430, (Fed Cir. 2002) repeats this fundamental principle:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Judge Newman went on to advise the PTO that it cannot meet that test by simply saying that the basis for combining references comes from "common knowledge" or is "common sense", viz:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act...The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense", even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. *Id.*

The CCPA earlier expressly held that there must be some logical reason **apparent from the evidence of record** that would justify a combination or modification of references. *In re*

Regel, 188USPQ 132 (CCPA 1975).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) address this subject, viz:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect taught is used against the teacher." (*Id.* At 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*Id.* at 1369, 55 USPQ2d at 1316) (citations omitted).

(c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing

is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ...

Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not “evidence.” (*Id.* at 1370, 55 USPQ2d 1317) (citations omitted).

In the present Office Action, the Examiner does not provide a motivation for either combining modifying *McClain* to achieve the invention as defined in claim 11, *except to achieve the end function only identified by the Applicant*, which, as shown above, is impermissible. The Applicant is thus left to guess the nature of the modification(s) and to guess the motivations for alterations. This is clearly contrary to above cited law that requires the Examiner to specifically define elements, specifically identify alterations and the motivations for making the alterations, and to specifically identify motivation for making combinations. However, there are no findings that would justify a motivation to modify Rodgers to achieve any of the teachings of invention. Further, the Examiner does not provide any findings to justify the modifications, as is required to make a *prima facie case* of obviousness. Accordingly, withdrawal of the rejections to claim 11 and those that depend therefrom respectfully requested.

Further Considerations Regarding Non-Obviousness

1. References Are Not Properly Combinable or Modifiable if the Reference(s) Teach Away From the Modification or Combination

If the prior art teaches away from a combination, then a §103 rejection does not rise to the dignity of *prima facie* obviousness. It is unnecessary to submit rebuttal evidence when the reference used to reject the claim teaches away from the limitation, or is silent on it and other art teaches away. In short, teaching away is the antithesis of the art suggesting that the person of ordinary skill go into the claimed direction. *In re Fine*, 873 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Essentially, teaching away from the art is a per se demonstration of lack of *prima facie* obviousness.

In re Hedges, 783 F.2d 1038, USPQ 685 (Fed. Cir. 1986), is a good example of the Federal Circuit's contribution to the subject. Hedges has stressed to the PTO that his invention incorporated the reaction to diphenyl sulfone at a temperature above its melting point of 127° C. Hedges argued before the board that the lower temperature shown by the prior art defeats any *prima facie* case of obviousness. The board held that Hedges had not produced "persuasive objective evidence" in rebuttal. The board thus considered the references to define a *prima facie* case which was not rebutted.

On appeal, the Federal Circuit pointed out that "only after the PTO had made a *prima facie* case of obviousness does the burden of coming forward shift to the applicant..." Judge Newman determined that the basic reference alone does not, as asserted by the PTO, support a *prima facie* case of obviousness. She observed that the reference (Felix) makes clear that low temperatures are the desired conditions for the claimed reaction.

The apex of nonanalogous art law in defeating an erroneous USPTO rejection of *prima facie* obviousness in *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (fed. Cir. 1992). The court held the prior art process references to be nonanalogous to the claimed invention even though both were used in the petroleum industry and both involved handling petroleum products in volumetric enclosures. The claimed invention was a method for *storing refined* petroleum products in a *man-made* storage tank. The references were to be a method for *extracting crude* oil *porous* hydrocarbon-bearing *natural underground* formations. These italicized features, the court said, show a different "field of endeavor" and different "*purposes*," which defeat the possibility of dealing with or solving a common problem. That neither of *Rodgers* or *Smith* is a divot fixer show that they are non-analogous to the invention. In addition, since *Rodgers* teaches a golf tee placer and *Smith* does not, it shows that they are non-analogous and are thus not combinable.

The fact that *McClain* does not mention that his invention can be used as a tanning solution applicator, when coupled with the fact that he goes on to include a neck-level collar opening in his invention (specifically to avoid getting tanning lotion on a face), shows that

McClain does not consider his invention to be usable or modifiable for use as a tanning solution applicator. This is quite a powerful teaching away from the Examiner's assertion that *McClain's* device can be used as, or is modifiable to end up with, a tanning solution applicator as defined by the applicant in claim 11. If Rodgers device were usable as a tanning solution applicator, surely he would have said so. This teaching is absent precisely because *McClain's* device is not a tanning solution applicator and is not usable as a tanning solution applicator, and because *McClain* cannot be reasonably modified to produce a divot fixer as defined by the applicant in claim 11. Thus, for the Examiner to suggest that he can modify *McClain* to get a tanning solution applicator is impermissible since *McClain* teaches away from using his device as a tanning solution applicator, and is only contemplatable in hindsight in view of the Applicant's disclosure. Accordingly, the rejections under 35 USC 103 to claim 11 based on *McClain* (modified) should be withdrawn and withdrawal of the same is requested.

Requirement of Enablement to Qualify as a Reference

A reference relied upon must be enabling. In *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659, 665 (Fed Cir. 1986): "[A] §102(b) reference must sufficiently describe the claimed invention to have placed the public in possession of it . . . [E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling . . ." See also, *Akzo N.V. v. U.S.I.T.C.*, 808 F.2d 1471, 1479 (Fed. Cir. 1986) ("the prior art reference must be enabling. . ."). The reference must be enabling with respect to the claimed invention (as opposed to the underlying device or method taught in the reference). If the reference is inoperative with respect to the claimed invention, then the reference does not teach the invention and is not prior art. In *re Shepard*, 172 F.2d 560 (C.C.P.A. 1949). *McClain* teaches a device for applying sun tan lotion, but does not teach a device for applying tanning solution.

The assertion that *McClain* teaches a tanning solution applicator is improper. A user seeking a tan needs an even coat of solution to avoid the creation of a "farmer's tan." The neck-high enclosure of *McClain* renders the device useless and non-enabling as a tanning solution

applicator, in part, because using *McClain* to deliver tanning solution would necessarily leave a user with a farmers tan. A non-enabling reference must not even be considered as a reference. *In re Wilder*, 429 F.2d 447 (C.C.P.A. 1964). Accordingly, the Examiner is respectfully requested to withdraw the rejection to the Applicant's invention under 35 USC §103 in view of *McClain*.

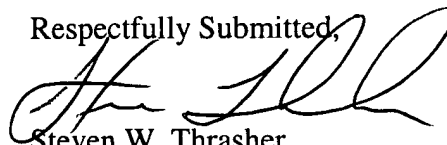
The Examiner Impermissibly Applies a Device Patent to a Method Claim

A process patent can only be anticipated by a similar process. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403 (1902). Accordingly, rejections to claim 11 and those that depend therefrom should be withdrawn.

Conclusion and Prayer for Relief

In summary, independent Claims 1, 11, 17 are amended. Claims 3, 8, 9, 12, 13, and 16 are now in condition for allowance as per Examiner's instructions. It is also believed that claims 1, 2, 4-7, 10, 11, 14, 15, and 17-20 are also in condition for allowance, and allowance of the same is requested. Specifically, since it is believed that independent claims 1, 11 and 17 are now in condition for allowance it is noted that each dependent claim is also in condition for allowance, and thus allowance of each dependent claim is also requested. **If the Examiner has any other matters which remain, the Examiner is encouraged to contact the under signed attorney to resolve these matters by Examiners Amendment where possible.**

Respectfully Submitted,



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